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AUG 24 2004

OFFICE OF PETITIONS

In re Application of :
Leonard and Taylor :
Application No. 10/706,792 : DECISION REFUSING STATUS
Filed: 12 November, 2003 : UNDER 37 CFR 1.47(a)
Atty. Docket No. 4774-111 US :

This is in response to the petition filed under 37 CFR 1.47(a) on 22 July, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 12 November, 2003, without an executed oath or declaration. Accordingly, on 23 February, 2003, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing as well as replacement drawings in compliance with 37 CFR 1.84 and 1.121.

In response, on 22 July, 2004, the present petition and petition fee were filed, along with a three (3) month extension of time and the late filing surcharge. A declaration naming Todd F. Leonard and Maurice R. Taylor as joint inventors and signed by joint inventor Taylor on behalf of himself and on behalf of joint inventor Taylor was also filed.

Petitioners' counsel asserts that a copy of the declaration was sent to the non-signing inventor, but that the non-signing inventor has refused to sign it.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not provided proof that Leonard was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).¹ The letter sent to joint inventor Leonard on 19 April, 2004, states only that a copy of the declaration is enclosed. However, in order for a Rule 47 petition to be granted, the inventor **must** be afforded an opportunity to review the application.² Therefore, petitioners should send a copy of the application papers to Leonard's last known address. Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application

¹MPEP 409.03(d).

²See In re Gray, 115 USPQ 80 (Comm'r Pat. 1956). The application papers must be sent or given to the non-signing inventor unless he or she refuses to accept delivery of the papers.

was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petitions
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
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